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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,863	04/12/2001	Tomoyuki Funaki	5259-000001	5194
27572	7590	11/17/2004	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			HANNE, SARA M	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/833,863

Applicant(s)

FUNAKI, TOMOYUKI

Examiner

Sara M Hanne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/24/94.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the amendment received on August 24, 2004.

Amended Claims 1-17 are pending in the application.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4-5, 10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-5, 7-8, 10-11, 13-15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Eyzaguirre et al., US Patent 6353170.

As in Claim 1, Eyzaguirre et al. teaches a performance information edit and playback apparatus comprising a storage for storing style data, each of which has constituent parts regarding accompaniment and for storing user's performance data having performing parts wherein each of the constituent parts and the performing parts contains a series of musical tone event data arranged in time series ("Music samples are independent pieces of music composed by a musician and stored in memory ... each sample is one measure long.", Column 4, lines 36-38), and the user's performance data are created by a user: a first display section for displaying contents of the performing parts included in the user's performance data in a time-series manner (Instrument row 730), a style selector for selecting a desired style data from among the style data in accordance with a user's instructions (Column 4, line 25 et seq.) and a second display section for displaying blocks designating the constituent parts included in the selected style data (sample selector 720), and a controller for allowing one of the blocks which is selected by the user's instruction and is displayed in the second display

section to move to a desired time-related position within a desired performing part displayed in the first display section (Column 4, lines 52-56), thus writing a series of the musical tone event data included in the constituent part designated by the block that is selected, to the desired time-related position in the desired performing part (Figure 7 and corresponding text).

As in Claim 2, Eyzaguirre et al. teaches a pitch modifier for automatically modifying tone pitches of the selected constituent part of the style data (harmonizer program 310).

As in Claim 3, Eyzaguirre et al. teaches the first display section displays the content of the performing part included in the user's performance data as the block (Figure 7).

As in Claims 4, 10 and 14, Eyzaguirre et al. teaches a performance information edit and playback apparatus, method and machine-readable media comprising: a storage for storing style data having prescribed accompaniment parts and for storing user's performance data having accompaniment parts and other performing parts (Figure 7), not related to the accompaniment such as melody parts (one line of the composition may be the melody), wherein the style data are fixed and are not rewritten (harmonizer program not activated), and the user's performance data are created by a user, a selector for selecting one of the accompaniment parts included in the user's performance data and the prescribed accompaniment parts included in the style data in accordance with a user's instruction (Column 4, lines 25-56), and a playback device for playing back the other performing parts included in the user's performance data in

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parallel with one of the accompaniment parts included in the user's performance data and the prescribed accompaniment parts included in the style data (Figure 7, ref. 750 and Col. 4, line 67- Col. 5, line 6).

As in Claims 5 and 8, Eyzaguirre et al. teaches both of the accompaniment parts included in the user's performance data and the prescribed accompaniment parts included in the style data commonly share a same tone-generation channel or a same tone color (Col. 5, line 14 et seq.).

As in Claims 7, 13 and 17, Eyzaguirre et al. teaches a performance information edit and playback apparatus, method and machine-readable media comprising a storage for storing style data, each of which has constituent parts regarding accompaniment and for storing user's performance data having performing parts wherein each of the constituent parts and the performing parts contains a series of musical tone event data arranged in time series ("Music samples are independent pieces of music composed by a musician and stored in memory ... each sample is one measure long.", Column 4, lines 36-38), and the user's performance data are created by a user, a style selector for selecting a desired style data from among the style data in accordance with a user's instructions (Column 4, line 25 et seq.), displaying a performing data window which displays user's performance data with regard to each of performing parts in a time series manner (Instrument rows 730), and a style data window for displaying blocks designating the constituent parts included in the selected style data (sample selector 720), and a controller for allowing one of the blocks which is displayed in the style window to be selected by the user's instruction to a desired time-

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related position within a desired performing part displayed in the performance data window (Column 4, lines 52-56), thus writing a series of the musical tone event data included in the constituent part designated by the block that is selected, to the desired time-related position in the desired performing part (Figure 7 and corresponding text), a pitch modifier for automatically modifying tone pitches designated by the series of musical tone event data included in the constituent part designated by the block written at the desired time-related position in the desired performing part to suit chord information previously assigned to chord sequence in the performance data window (harmonizer program 310) and a length adjuster for automatically adjusting a length of the series of musical tone event data, included in the constituent part designated by a one block that is written at the desired time-related position in the desired performing part to conform with a specific part of the user's performance data (Column 5, lines 16-20).

As in Claims 11 and 15, Eyzaguirre et al. teaches a performance information edit and playback method and machine-readable media comprising a storage for storing style data containing constituent parts and storing user's performance data having multiple parts allowing a user to alternatively select either a prescribed part within the multiple parts of the user's performance data or one of the constituent parts of the style data (Figure 7 and corresponding text) allowing simultaneous reproduction on either the prescribed part of the user's performance data, or the constituent part of the style data which is alternatively selected, together with a part of user's performance data excluding

the prescribed part (when the play button is pressed the instrument rows 730 of compositions are played or reproduced simultaneously).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6, 9, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eyzaguirre et al., US Patent 6353170 and Hayakawa, US Patent 5326930. Eyzaguirre et al. teaches a performance information edit and playback apparatus, method and machine-readable media as seen *supra*. While Eyzaguirre et al. teaches an apparatus for recording and sequencing user-performance data, they fail to show the record mode discriminator and corresponding display changes as recited in the claims. Hayakawa teaches an edit and playback apparatus with music sequencer similar to that of Eyzaguirre et al. In addition, Hayakawa further the user selected section of user performance data be selected so that recording of performance data on that part may begin (punch-in/punch-out switch 17, Column 5 lines 52-65) using a record and start switch (reference numbers 11,26 and 15). Specifically including a record mode discriminator, which discriminates whether a recording part representing a performance part set to a record mode exists within parts forming user data (LED



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discriminates whether data has been recorded or not) and displaying the start switch differently in response to the discriminator ("The normally off LED ... stays lit when a punch-out timing is set.", Columns 5-6, Lines 68-1). It would have been obvious to one of ordinary skill in the art, having the teachings of Eyzaguirre et al. and Hayakawa before him at the time the invention was made, to modify the edit and playback apparatus taught by Eyzaguirre et al. to include the record mode discriminator and corresponding display changes of Hayakawa, in order to obtain a way to distinguish recording sections. One would have been motivated to make such a combination because a more flexible recording apparatus and method would have been obtained, as taught by Hayakawa

***Response to Amendment***

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar remote control systems for devices and remote accessing methods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh

  
BA HUYNH  
PRIMARY EXAMINER